

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re REISSUE Application for U.S. Patent 5,815,293

Yoshiaki KOMMA et al

Serial No. 09/671,674

Filed : September 27, 2000



Group Art Unit: 2872

Examiner:

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING DIFFERENT THICKNESSES

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Dear Sir:

Transmitted herewith is a **RESPONSE** in the above identified application.

- ☐ No additional fee is required.
- ☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
- ☒ Also attached: 1) **Petition for Extension of Time**; 2) **Form 2038**; 3) **Change of Correspondence Address**

The fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	132	132	0	x \$ 18 =	\$ 0.00
Independent Claims	29	29	0	x \$ 84 =	\$ 0.00
If multiple claims newly presented, add \$280.00					\$0.00
Fee for extension of time					\$400.00
Fee for Notice of Appeal					\$0.00
TOTAL FEE DUE					\$400.00

- ☒ Form 2038 authorizing payment in the amount of **\$400.00** is attached
- ☒ The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 50-1088, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

CLARK & BRODY

Israel Gopstein
Registration No. 27,3331750 K Street, N.W. Suite 600
Washington, D.C. 20006
Date: March 25, 2002(202) 835-1111
(202) 835-1755 (fax)

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231, ON THE DATE SHOWN BELOW

March 25, 2002

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Docket No.: 041-1714BRI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application for U.S. Patent 5,815,293

Yoshiaki KOMMA et al.

Serial No. 09/671,674

Filed: September 27, 2000

Group Art Unit: 2872

Examiner: HENRY, J

For: COMPOUND OBJECTIVE LENS FOR OPTICAL DISKS HAVING
DIFFERENT THICKNESSES

RESPONSE TO OFFICIAL ACTION and REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

In response to the Official Action dated October 23, 2001, the time for response to which is extended by the accompanying Petition and Fee payment for TWO months, up to and including March 23, 2002, a Saturday and hence to Monday, March 25, 2002, applicants respectfully request reconsideration of the rejections set forth therein for the following reasons.

The Official Action

At Paragraph 1 of the Action of October 23, 2001, the Examiner notes that the application was filed without the required offer to surrender the original patent. Applicants will provide such an offer in due course.

At Paragraph 2 of the Action, the Examiner asserts that the declaration filed with the application is defective. It is respectfully noted that this is the only stated grounds for rejection. More particularly, at page 4 of the Action, the final sub-paragraph of Paragraph 2 sets forth the rejection as follows:



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“Claims 1-132 are rejected as being based upon a defective reissue declaration under 35 USC 251 as set forth above.”

No other rejection is made.

On the other hand, Paragraph 2 of the Action raises other points of argument or discussion. It is courteously submitted, however, that such arguments have not been applied as a basis for rejection of any of the pending claims and, accordingly, have no bearing on the rejection of record.

In an attempt to clarify the situation, on January 3, 2002, an extended telephone conference was conducted with the Examiner in connection with the Official Action. Undersigned attorney for applicants wishes to thank the Examiner for the courtesies extended during the telephone interview. During the conference, the Examiner clarified his position with respect to the other points raised in the Action.

The following presents applicants' response to the pending rejection, as well as a number of comments relating to the other points raised in the Action.

1. The Declaration

It is first noted that the USPTO has clearly established the requirements for a Declaration in a Reissue Application. These requirements are set forth at 37 CFR 1.175. In support of these requirements, in PTO Form SB51 the USPTO has provided a standard form for making such a Declaration.

The Commissioner has thus provided a form which meets the only requirements for filing an application.

It is noted that the Declaration provided in the present application was entirely based on Form SB51 as it existed at the time of making the Declaration, and customized to the circumstances of the present application.

Once an applicant has fully complied with the requirements established by the Commissioner of Patents and Trademarks, the Commissioner does not then impose additional requirements. The Examiner is courteously reminded that while the

Commissioner has delegated limited authority to the Examining Corps, no Examiner may overrule the Commissioner. Nor may any Examiner impose requirements in addition to those established by the Commissioner in the Code of Federal Regulations, for to do so would mean that the Commissioner, acting through the Examiner, will have established a requirement on an applicant which is additional to that set forth in the Code.

In the present instance, after the normal deliberative procedure for establishing Rules of Practice, the only requirements established by the Commissioner for identification of error in fulfilling the statutory requirements of 35 USC 251 are set forth at 37 CFR 1.175 and PTO Form SB51.

These requirements include section (a), which requires “that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.”

The Present Declaration Meets the Requirements of 37 CFR 1.175(a)(1)

To conform with 37 CFR 1.175(a)(1), PTO Form SB 51 thus sets forth a preprinted statement that “I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below.”

It is noted that applicants’ Declaration includes precisely the same statement, thus conforming to the USPTO’s own prescription for meeting the requirements of 37 CFR 1.175(a)(1).

37 CFR 1.175(a)(1) further sets forth that applicant state at least one error being relied upon as the basis for reissue.

PTO Form SB 51 thus sets forth the following preprinted list of errors, at least one of which is required to be checked:

☐ by reason of a defective specification or drawing.

☐ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☐ by reason of other errors.”

It is first noted that the third checked statement, “☐ by reason of other errors”, is clearly explanatory of the fact that the first two checked statements provide two types of error (essentially the most common errors on which reissue is based), but that in addition to these two errors, “other” errors may also occur.

Applicants’ Declaration includes precisely the same check boxes, and applicants had checked the second box, thereby stating that the error relied upon is “the patentee claiming more or less than he had the right to claim in the patent.”

It is quite clear that *this error supports reissue of all newly presented claims.*

The Declaration thus conforms to the USPTO’s own prescription for meeting the requirements of 37 CFR 1.175(a)(1) as to stating at least one error being relied upon as the basis for reissue.

Applicants thus submit that the present Declaration conforms with the requirements of 37 CFR 1.175(a)(1).

The Present Declaration Meets the Requirements of 37 CFR 1.175(a)(2)

37 CFR 1.175(b)(2) sets forth the requirement that the Declaration must state that “All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.”

To conform with 37 CFR 1.175(a)(2), PTO Form SB 51 thus sets forth a preprinted statement that “All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.”

It is noted that applicants' Declaration includes precisely the same statement, thus conforming to the USPTO's own prescription for meeting the requirements of 37 CFR 1.175(a)(2) as it existed at the time of preparation of the Declaration.

The Provisions of 37 CFR 1.175 (b) are Not Applicable

At 37 CFR 1.175(b), the Code sets forth that "For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

Inasmuch as all errors are covered by the declaration submitted under paragraph (a), that is, all errors being corrected are covered by a declaration stating that the error being corrected occurred "by reason of the patentee claiming more or less than he had the right to claim in the patent", no supplemental oath or declaration is required under 37 CFR 1.175(b).

If other claims are subsequently added, or if the claims are amended during prosecution, and if the amended or added claims are not covered by the error "of the patentee claiming more or less than he had the right to claim in the patent", then a supplemental declaration may be required at some point. However, at the present instance, no such supplemental declaration is required or necessary under the provisions of 37 CFR 1.175(b).

Therefore, at the time of filing and to the present time, applicants' Declaration clearly complies with the requirements of 37 CFR 1.175(b).

The Provisions of 37 CFR 1.175 (c) are Not Applicable

At 37 CFR 1.175(c), the Code sets forth that "Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath

or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.”

In the present instance, all errors stated in the oath or declaration (“claiming more or less than he had the right to claim” are still being corrected). Therefore, by the terms of the Code, “a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.”

Thus, even *if* a supplemental declaration were required, it is explicitly stated that, at least at this time, the applicant “need not specifically identify any other error or errors being corrected.”

Therefore, at the time of filing and to the present time, applicants’ Declaration clearly complies with the requirements of 37 CFR 1.175(c).

Additional Error

It is also noted that, in addition to the error of “claiming more or less than he had the right to claim”, applicants have identified another error relating to the fact that, during prosecution, through inadvertence and without deceptive intent, at least one claim depending from a subsequently issued claim was cancelled during prosecution.

That is, at least one dependent claim which would have issued in the original patent, but for an inadvertent cancellation not required for allowance, had been cancelled notwithstanding allowability and subsequent issuance of its parent claim. Thus, applicants have identified yet another error on which reissue is based.

However, there is no requirement in either 37 CFR 1.175 or in 35 USC 251 that applicants identify which claim or claims was involved in this error.

To the extent that the Declaration meets the statutory and regulatory requirements of 37 CFR 1.175 and 35 USC 251 without stating the additional error upon which reissue is based, and in order to expedite prosecution, applicants will (if requested by the Examiner) provide a revised Declaration in which the additional error is deleted.

In any case, whether or not such a revised Declaration is requested, it is respectfully submitted that the Declaration provided with the Application is in full compliance with the provisions and requirements of 37 CFR 1.175 as well as 35 USC 251, and that no basis exists for rejecting the claims as being based on a defective Declaration.

The Examiner is courteously requested to identify any authority on which the rejection relies, in order to permit applicants a proper opportunity to rebut, or conform with, the same.

Additional Arguments

Beginning at the first full paragraph of page 3 of the Action, the Examiner addresses other issues, for which no support is provided either in 37 CFR 1.175, in 35 USC 251, or in the MPEP. Yet these are the authorities which control the nature of patent examination. Thus, although the Examiner has not identified any statement which is required in the Declaration by 37 CFR 1.175 and which has not been made, the Action instead adds requirements for the Declaration to address:

“how (a) the inventions newly claimed in reissue are not directed to ‘entirely distinct’ inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (b) the inventions newly claimed in reissue are directed to ‘entirely distinct’ inventions but *Weiler* is not controlling case law in this instance”, referring to *In re Weiler* 790 F.2d 1576, 1581, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

Based on this interpretation of case law, the Action then asserts that “it appears applicants’ declaration is defective for failing to establish statutory error under 35 USC 251 in accordance with *Weiler*.” A following analysis as to statutory error is based on *FEC v. Democratic Senatorial Campaign Committee*, 454 US 27, 32 (1981). The analysis, however, fails to identify any judicial decision which determines any impropriety in the Commissioner’s interpretation of the statute as provided at 37 CFR 1.175.

Rather, the analysis of the Rule changes of the USPTO, beginning at the second full paragraph of page 3 of the Action, appears to subsume the authority of a reviewing federal court and to take unto the Examiner the authority to determine that the Commissioner's "construction of the statute, whether reached by adjudication or by rulemaking, [is] inconsistent with the statutory mandate or [frustrates] the policy that Congress sought to implement".

In clarifying the situation in the above referenced telephone interview, the Examiner appeared to state that the applicants' intent to claim the subject matter of the added claims would determine whether such claims could be considered in the reissue application or would conform to requirements for "statutory error" and be covered by the declaration, and whether indeed the new claims are to the "same invention", or "the invention disclosed in the original patent".

During the interview, it was stated that the Federal Circuit had clarified what is statutory error in *In re Weiler* and that, although the decision of the Federal Circuit in *In re Amos*, 953 F.2d 613, 617, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991), was thought by some to have overruled *Weiler*, such was not the case.

The following remarks are provided to clarify any misconception as to the case law, statutory error, and any inferences as to whether or not applicants' "intent to claim" is relevant to statutory error, and (in light of the analysis in the Action) to sufficiency of the Declaration.

Question of "Same Invention"

The statute (at 35 USC 251) requires that, under certain circumstances, "the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent."

This language and its predecessors have been interpreted as requiring a reissue patent (whether broadening or not) to be for the same invention as disclosed in the original patent.

The history, intent and purpose of tests underlying the question of whether a reissue application is for the “same invention” are well set out in the decisions of the U. S. Supreme Court and the CAFC, as well as its predecessor court the Court of Customs and Patent Appeals (CCPA). It is respectfully submitted that, as is clear from the following, this question is answered by straightforward determination of whether or not the claims of the reissue application meet the description and enablement requirements under 35 USC § 112 ¶ 1.

Although tests for the “same invention” had erroneously previously relied on an “intent to claim” in the original patent, that criterion has now been determined by the CAFC to be one which is not based in the statute and which, while providing a point of interest, is not at all dispositive of the question of “same invention”.

It is therefore submitted that any assertion that the claims in the pending application may not be for the “same invention” (or more correctly, “the invention disclosed in the original patent”) based on an “intent to claim” analysis is in error.

The “Original Intent” or “Intent to Claim” Test Has Been Eliminated

The “original intent” test was recognized from 1832 to 1952. This test was enunciated in *Parker & Whipple Co. v. Yale Clock Co.* 123 U.S. 87, 8 S. Ct. 38 (1887), where the Court stressed that it must appear “from a comparison of the two patents that the original patent embodied, as the invention intended to be secured by it, what the claims of the reissue are intended to cover.” It was not sufficient that the original specification or drawings disclosed the structure later claimed. More particularly, the Court stated that

“[W]hile the new description may properly contain things which are indicated in the original specification, drawings, or patent-office model, (though not

sufficiently described in the original specification,) it does not follow that what was indicated in the original specification, drawings, or patent-office model is to be considered as a part of the invention, unless the court can see, from a comparison of the two patents, that the original patent embodied, as the invention intended to be secured by it, what the claims of the reissue are intended to cover.” 123 U.S. at 99.

It is respectfully submitted, however, that the court-made “original intent” test was statutorily removed in the 1952 act.

More particularly, Section 251, enacted in 1952, substituted the phrase “the invention disclosed in the original patent” for “the same invention.”

However, some subsequent court decisions continued to treat Section 251 as continuing the prior precedents on “same invention,” including *Parker & Whipple*. For example, in *In re Rowand* 526 F.2d 558, 187 USPQ 487 (CCPA 1975) the court held that

“Determining what protection appellants intended to secure by their original patent for the purposes of § 251 is an essentially factual inquiry confined to the objective intent manifested by the original patent. ... [T]here is nothing in the original patent evidencing that appellants intended to claim a method of making tubing or that appellants considered the method now claimed to be their invention.” 526 F.2d at 560.

However, as noted in Chisum on Patents, in *In re Hounsfield* 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983), the Federal Circuit “deflated” the “intent” test. More particularly, after the Board of Appeals affirmed a rejection of a reissue application only “for lack of an objective intent to claim the subject matter of these claims in the original patent”, the court emphasized that “intent to claim” was not an independent basis for denying a reissue application under Section 251, stating that “It is only one factor that sheds light upon whether the claims of the reissue application are directed to the same invention as the original patent and the reissue would correct an inadvertent error in the original patent.”

Further, although *In re Weiler* (*supra*), does not decide a question of broadening reissue, the court stated that

“When, unlike the present case, a reissue applicant seeks to obtain a broadened version of a claim in the patent, one may look to see whether the disclosure ‘reasonably conveys to one skilled in the art that the inventor had possession [emphasis added] of the broad invention at the time the original application was filed’”, citing *In re Peters* 723 F.2d 891, 221 USPQ 952, (Fed. Cir. 1984).

Thus, the court has taken the position that in a broadening reissue, the question is one of *possession of the invention*, rather than intent to claim, and that such possession (as evidenced by meeting the requirements of 35 USC 112) would support a broadening reissue.

The Correct Test for Same Invention: Could the Claims Have Been Made in the Original Patent

In moving away from the “intent to claim test” and moving towards the “disclosure” test, the Court, in fact, has been using language which effectively resolves the “same invention” test by questioning whether the claims could have been made in the patent for which a reissue application has been filed.

In re Amos

Similarly to *Weiler*, in *In re Amos*, 953 F.2d 613, 617, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) the court held that

“The ‘original patent’ clause of § 251 creates a requirement that precludes reissue, historically styled as a ‘same invention’ rejection, of patents with claims to subject matter that could not have been claimed [emphasis added] in the original patent that is submitted for reissue.”

In directly addressing the question of whether the “same invention” criterion is met, the *Amos* court held that “the presence or absence of an objective intent to claim, standing alone, is simply not dispositive of any required inquiry” under the reissue statute, 35 U.S.C. Section 251. Rather, the court held that

“the issue of whether the tests for written description and enablement under § 112 ¶ 1 and for ‘same invention’ under § 251, are in every case exactly co-extensive.”

By stating that the two tests are “exactly co-extensive”, the court clearly holds that if claims meet the test for the same invention then they meet the tests for written description and enablement, and if the claims meet the tests for written description and enablement then they meet the test for same invention.

It is significant to consider the court’s analysis in establishing the test.

“[T]he purpose of the rubric ‘intent to claim’ is to ask the same question as to whether ‘new matter’ has been ‘introduced into the application for reissue’ thus, perforce, indicating that the new claims are not drawn to the same invention that was originally disclosed. That inquiry is but a restatement of the question whether that which is claimed in reissue could have been claimed [emphasis added] on the basis of the original disclosure, given that the requisite inadvertent error has been demonstrated ... Thus, the inquiry that must be undertaken to determine whether the new claims are ‘for the invention’ originally disclosed ... is to examine the entirety of the original disclosure and decide whether through the ‘objective’ eyes of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application, given that the requisite error has been averred ... [T]he inquiry under § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112 ¶ 1. Under one aspect of that analysis, a court must ascertain whether ‘the disclosure originally filed [conveys] to those skilled in the art that applicant had invented the subject matter later claimed.’” 953 F.2d at 618, 21 USPQ2d at 1274-75 (citing *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978))

Subsequent Decisions of the CAFC

As the *Amos* decision has apparently not been fully appreciated, the CAFC has taken care to clarify its significance.

For example, in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1484-85, 46 USPQ2d 1641, 1651 (Fed. Cir. 1998) the court held that a

“district court’s conclusion that the ‘original patent’ clause of § 251 was not satisfied based on an ‘objective intent to claim’ requirement was in error.”

In explaining its holding, the CAFC elaborated on the rule to be followed in answering the issue:

“This court squarely addressed the issue in *Amos*. ... The *Amos* court held that § 251 does not include a separate requirement of an objective intent to claim. ... Rather, the court concluded: ‘the essential inquiry under the “original patent” clause of § 251 ... is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees.’ ... The court noted that this inquiry is analogous to the ‘written description’ requirement of 35 U.S.C. § 112 ¶ 1 (1994). ... The court further stated that, to the extent the construct of an objective intent to claim is useful, it is ‘only one factor that sheds light’ on whether the ‘original patent’ clause of § 251 is satisfied. ... (quoting *In re Hounsfield*. ...)”.

“With regard to the Supreme Court's opinion in *U.S. Industrial*, ... the *Amos* court noted that that case was decided under the predecessor reissue statute which required reissue claims to be for the ‘same invention,’ and concluded that *U.S. Industrial* does not now mandate a separate ‘objective intent to claim’ requirement. ... The *Amos* court noted that this court reached the same conclusion eight years earlier in *Hounsfield*. ...”)

To the extent that ‘intent to claim’, or ‘objective intent’, may remain as a factor to be considered, in *Hester Industries Inc. v. Stein Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 372 (1998) the CAFC further explained the manner in which this factor may be met. Therein, the court held:

“It is well-settled that an inventor need not have the subjective intent to claim the broadened invention for a reissue to be appropriate. ... But reissue does require an ‘objective’ intent manifested in the original patent. *Id.* In other words, looking at the claims, drawings, and specifications of the original patent, a person with ordinary skill in the art must be able to conclude that the inventor could have claimed the new subject matter in the original application. ... ‘Could have claimed’ does not mean that a claim is merely indicated or suggested by the specification. To the contrary, the proper standard requires the specification to have been capable of supporting all of the elements of the new subject matter had that matter been included in the original patent.”

Based on the foregoing, applicants respectfully submit that:

- 1) The Declaration as filed is in full conformity with the requirements of 37 CFR 1.175 as well as 35 USC 251;
- 2) Reconsideration of the only rejection is thus in order; and
- 3) Unless the Examiner demonstrates that the pending claims *could not have been made* in the original patent, failure to include, prosecute and obtain allowance and issuance of such claims is sufficient statutory error to warrant the present reissue application.

In view of the foregoing, full examination of the claims on the merits is in order and the same is courteously solicited.

Respectfully submitted,

CLARK & BRODY



Israel Gopstein
Registration No. 27,333

1750 K Street, N.W. Suite 600
Washington, D.C. 20006
(202) 835-1111
(202) 835-1755 (fax)
Date: March 25, 2002

CERTIFICATE OF MAILING

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March 25, 2002

ISRAEL GOPSTEIN

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